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| 09/641,866      | 08/18/2000  | Charles E. Bernasconi | P/3639-21           | 7547             |

7590 07/19/2004  
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BELLEVUE, WA 98004

EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,866

Applicant(s)

BERNASCONI ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 23-28, 30-32, 36, 37, 41-44, 48-51, 53 and 58-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 23-28, 30-32, 36, 37, 41-44, 48-51, 53 and 58-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 21 April 2004. Claims 17, 18, 23-28, 30-32, 36, 37, 41-44, 48-51, 53 and 58-71 are pending. Claims 37 and 44 have been amended. Claims 60-71 are newly added.

### ***Requirement for Information Under 37 C.F.R. § 1.105***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. The information is required to identify products and/or services embodying the disclosed subject matter of a system allowing a user to set up a database of employees, wherein the database has information about qualifications of each of the employees, determining an open position requiring at least one qualification by playing the role of a teacher reporting an absence and specifying qualifications for a substitute, sorting the employees in the database into those having the qualification and those not having the qualification, and simultaneously notifying those employees in the database having the qualification by posting the information about the open position to a web page for each qualified employee that is accessible from the Internet with a pass code (page 2, Declaration of Sue Lunsford).

The Examiner, upon conducting a search for prior art and thoroughly reviewing affidavits filed 21 April 2004, discovered the disclosure of a product which was used by Jay Boitano and Sue Lunsford. The product included the following: a system allowing a user to set up a database of employees, wherein the database has information about qualifications of each of the employees, determining an open position requiring at least one qualification by playing the role of a teacher reporting an absence and specifying qualifications for a substitute, sorting the employees in the database into those having the qualification and those not having the qualification, and simultaneously notifying those employees in the database having the qualification by posting the information about the open position to a web page for each qualified employee that is accessible from the Internet with a pass code (page 2, Declaration of Sue Lunsford).

In response to this requirement please provide any known materials, publications, brochures, manuals, and/or press releases that describe the aforementioned product that is described in the affidavits filed 21 April 2004 by Jay Boitano and Sue Lunsford, as well as the co-inventors Charles Bernasconi and Shannon Wainright.

3. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

4. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

6. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

***Specification***

2. The amendment to the title has been entered and considered.

***Claim Rejections - 35 USC § 112***

3. The rejection of claims 37, 41-44, and 48-50 under 35 USC 112, 2<sup>nd</sup> paragraph, are hereby withdrawn due to the amendment filed 21 April 2004.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-18, 23-28, 32, 37, 42, 44, 49, 51, 53, and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bukow (6,567,784) in view of Mitsuoka et al. (6,446,914).

(A) Claims 17-18, 23-28, 32, 42, 49, 51, 53, and 58-59 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 13; sections 5(A)-5(P)).

(B) The amendments to claims 37 and 44 appear to have been made to correct 35 USC 112, 2<sup>nd</sup> paragraph issues. The amendments do not affect the scope and breadth

of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 13; pages 8-11), and incorporated herein.

6. Claims 30-31, 36, 40, 43, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bukow (6,567,784) and Mitsuoka et al. (6,446,914) as applied to claim 26, 37, and 44, and further in view of Thompson et al. (6,334,133).

(A) Claims 30-31, 36, 40, 43, 48, and 50 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 13; sections 6(A)-6(B); pages 15-16).

7. Claims 60-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bukow (6,567,784) in view of Mitsuoka et al. (6,446,914) as applied to claims 17, 26, 37, 44, 51, and 58, and further in view of Joao (6,662,194).

(A) As per claims 60-71, Bukow and Mitsuoka fail to expressly disclose wherein the web page displays information specific to an employee that has previously filled the position, and wherein the information specific to an employee was entered to the database by the employee.

Joao teaches a database storing past employee information and types of positions, wherein the information is displayed on a web page, and wherein an

individual is able to transmit information to the database over a computer network related to the employee information (Fig. 1, col. 12 lines 9-18 and lines 38-47, col. 14 lines 45-60, col. 15 lines 46-63, col. 21 lines 32-43, col. 31 lines 55-67).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Joao within the method and system of Bukow and Mitsuoka with the motivation of automating job searching services in a network environment while reducing the time, expense, and effort needed in performing these services (Joao; col. 40 line 65 to col. 41 line 3).

### ***Affidavit***

8. Applicant has submitted an affidavit to remove Bukow (6,567,784) as a reference applied under 35 U.S.C. § 103(a) in the previous Office Action. The affidavit filed on 21 April 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Bukow reference (6,567,784) for the following reasons:

the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Bukow reference because:

(A) The declaration of Jay Boitano fails to establish a clear nexus between the statements made in paragraphs 3 and 4 and the claimed subject matter. The evidence is not commensurate in scope with the scope of the claims. In particular, there is nothing that directly ties the statements given in paragraphs 3 and 4 of the declaration with the language specifically recited in the claims. Applicant's reliance on the



declaration of Jay Boitano to antedate the previously applied reference is non-persuasive as the nexus between the overview and the features explicitly recited in the instant claims is not clearly established. Also, the Applicant has not pointed out the specific portions of the submitted materials directly tied to each and every element, feature, or step that is being claimed; and

(B) Based on the declaration submitted by Sue Lunsford, it appears that a product was used by Sue Lunsford. However, it is unclear to the Examiner whether the product being used as described in the declaration consists of the same system components of the claimed invention or performs the same steps as the claimed invention. The Applicant has not established sufficient evidence that shows whether the claimed invention was being used as of March 19, 1999. In conclusion, it does not appear there is a nexus between the product in the declaration submitted by Sue Lunsford and the invention as claimed.

### ***Response to Arguments***

9. Applicant's arguments filed 21 April 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 21 April 2004.

(A) As Applicant fails to provide any further arguments other than the reliance on Affidavit evidence that is ineffective to remove the Bukow reference for the reasons given above, the rejections are hereby maintained.

(B) Applicant's remaining arguments given at page 10 of the response filed 21 April 2004 rely upon or rehash the issues addressed above, and are therefore moot in view of the responses given in section 5(A) above, and incorporated herein.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**12. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7th Floor (Receptionist).

*CB*

CB  
July 8, 2004

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, stylized initial "A".

**ALEXANDER KALINOWSKI**  
**PRIMARY EXAMINER**